

Remarks

This response and accompanying Petition for Extension of Time are responsive to the Office Action mailed September 11, 2002 ("the Office Action"). In the Office Action, the Examiner rejected claims 1-49. By this amendment, and without introducing new matter, Applicant has cancelled claims 12-49, and has also amended the specification to correct minor typographical errors. Claims 1-11 are pending.

I. Information Disclosure Statement

Applicant is submitting an Information Disclosure Statement in accordance with 37 C.F.R § 1.97(c) with the fee set forth in 37 C.F.R § 1.17(p) with this response.

II. Claim Rejections 35 U.S.C. § 112

The Examiner rejected Claims 17-21 and 44-45 under 35 U.S.C. § 112. Applicant has cancelled claims these claims, thus the rejection is moot.

III. Claim Rejections 35 U.S.C. § 102(b)

A. Claims 4, 7, 12, and 17

The Examiner rejected Claims 4, 7, 12, and 17 as allegedly being anticipated by Greenawalt (United States Patent No. 4,528,705). Applicant respectfully traverses this rejection.

As to Claim 4

To be a proper reference under 35 U.S.C. § 102(b), the reference must teach each element of the claim. Contrary to the Examiner's assertion, Greenawalt does not teach a pillow that may be adjusted from a fully flat configuration to fully contoured configuration by inflating a bladder. While the firmness of the pillow is allegedly adjustable in Greenawalt (see column 1, lines 57-60), the shape of the pillow does not

depart from the pear-shape illustrated in the figures, except that in use, the pillow may be slightly flattened on its bottom wall portion from the weight of a user's head (see column 2, lines 60-62). This same description relied upon by the Examiner illustrates merely an indirect flattening of a constant pear-shaped pillow, and no way teaches a pillow that is adjusted from a fully flat configuration to fully contoured configuration by inflating a bladder. Thus, since Greenawalt does not teach each element of Claim 4, Applicant respectfully requests withdrawal of this rejection and reconsideration of this claim.

As to Claim 7

Further to the discussion of Claim 4 above, Greenawalt does not teach a pillow wherein the contour of the pillow is adjustable from nearly flat to fully contoured by inflation of the bladder. Nor does Greenawalt teach that the contour of the pillow is adjustable in discrete increments. Thus, since Greenawalt does not teach each element of Claim 7, Applicant respectfully requests withdrawal of this rejection and favorable reconsideration of this claim.

As to Claims 12-17

These claims have been cancelled, thus the rejection is moot.

B. Claims 38 and 41-42

These claims have been cancelled, thus the rejection is moot.

IV. Claim Rejections 35 U.S.C. § 103

A. Claims 1, 10, 15, 22-26, and 28-37

The Examiner rejected Claims 1, 10, 15, 22-26, and 28-37 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Greenawalt (United States Patent No. 4,528,705) in view of Walpin (United States Patent No. 6,182,312). Applicant

respectfully traverses this rejection and submits that the Examiner has failed to meet the requisite *prima facie* burden for this obviousness rejection.

To establish a *prima facie* case of obviousness, the Examiner must demonstrate some suggestion or incentive in the references that would have motivated one of skill in the art to modify or combine the references to arrive at the claimed invention. See, *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). In addition, the Examiner must demonstrate that one of skill in the art would have had a reasonable expectation of success at the time the invention was made regarding the proposed modification. The Examiner must also demonstrate that the combination of references teaches or suggests all the limitations of the claims. See, *Manual of Patenting Examining Procedure* § 2143; *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970). The combination of references cited by the Examiner does not teach or suggest all of the limitations of the claims. Thus, since the Examiner has failed to meet his *prima facie* burden, Applicant respectfully requests withdrawal of this rejection and favorable reconsideration of the claims.

As to Claim 1

None of the cited references alone or in combination suggests a pillow that may be adjusted from a fully flat configuration to fully contoured configuration by inflating a bladder. As noted above, in *Greenawalt*, the shape of the pillow does not depart from the pear-shape illustrated in the figures, except that in use, the pillow may be slightly flattened on its bottom wall portion from the weight of a user's head (see column 2, lines 60-62). *Walpin* does not teach any manner of inflatable or contoured pillow. Thus, Applicant respectfully requests withdrawal of this rejection and favorable reconsideration of this claim.

As to Claim 10

Claim 10, which depends from Claim 7, is allowable for the reasons set forth above with respect to Claim 7. Applicant respectfully requests withdrawal of this rejection and favorable reconsideration of this claim.

As to Claim 15, 22-26, and 28-37

These claims have been cancelled, thus the rejection is moot.

B. Claim 2

The Examiner rejected Claim 2 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Greenawalt (United States Patent No. 4,528,705) in view of Walpin (United States Patent No. 6,182,312) and further in view of Greenawalt (United States Patent No. 4,501,034). Claim 2 depends from Claim 1, and is allowable for the reasons set forth above with respect to Claim 1. Applicant respectfully requests withdrawal of this rejection and favorable reconsideration of this claim.

C. Claims 3, 11, 16, and 21

The Examiner rejected Claims 3, 11, 16, and 21 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Greenawalt (United States Patent No. 4,528,705) in view of Walpin (United States Patent No. 6,182,312) and further in view of Pekar (United States Patent No. 5,372,487). Claims 3 and 11 depend directly or indirectly from allowable claims discussed in detail above, and are therefore allowable. Claims 16 and 21 have been cancelled. Thus, Applicant respectfully requests withdrawal of this rejection and favorable reconsideration of Claims 3 and 11.

D. Claims 5, 8, 13, and 18

The Examiner rejected Claims 5, 8, 13, and 18 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Greenawalt (United States Patent No. 4,528,705) in view of Greenawalt (United States Patent No. 4,501,034). Claims 5 and 8 depend directly or indirectly from allowable claims discussed in detail above, and are therefore allowable. Claims 13 and 18 have been cancelled. Thus Applicant respectfully requests withdrawal of this rejection and favorable reconsideration of Claims 5 and 8.

E. Claims 6, 9, 14, and 19

The Examiner rejected Claims 6, 9, 14, and 19 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Greenawalt (United States Patent No. 4,528,705) in view of Pekar (United States Patent No. 5,372,487). Claims 6 and 9 depend directly or indirectly from allowable claims discussed in detail above, and are therefore allowable. Claims 14 and 19 have been cancelled. Thus Applicant respectfully requests withdrawal of this rejection and favorable reconsideration of Claims 6 and 9.

F. Claims 27, 39-40 and 43-49

These claims have been cancelled, thus the rejections are moot.

Conclusion

Applicant asserts that pending Claims 1-11 are allowable. A petition for a three (3) month extension of time, extending the period for response to March 11, 2003, is enclosed with this response. Please grant any additional extension of time required to enter this response and charge any additional required fees (beyond the enclosed check) to our Deposit Account No. 50-0581.

Respectfully submitted this 11th day of March 2003.



Daniel McCarthy
Reg. No. 36,600
Parsons, Behle & Latimer
201 South Main Street, Suite 1800
Salt Lake City, Utah 84145
Tel: (801) 536-6830 or (801) 532-1234
Fax: (801) 536-6111
Email: DMcCarthy@pblutah.com



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: Tony M. Pearce
Title: Contourable Inflatable Orthopedic Pillow
Filed: April 25, 2001
Serial No.: 09/843,413
Docket: 5066 P
Examiner: Ho, Thomas Y.
GAU: 3677
Assistant Commissioner for Patents
Washington, DC 20231

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Certificate of Mailing

Honorable Assistant Commissioner:

I hereby certify that the attached Response to Office Action is being submitted via First Class Mail with the United States Postal Service in an envelope with sufficient postage on March 11, 2003, the envelope being addressed to: Assistant Commissioner for Patents, Washington, D. C. 20231.

Please charge any additional required fees (beyond the enclosed check) to our Deposit Account No. 50-0581.

Respectfully submitted this 11th day of March 2003.

Daniel McCarthy
Reg. No. 36,600
Parsons, Behle & Latimer
201 South Main Street, Suite 1800
Salt Lake City, Utah 84145
Tel: (801) 536-6830 or (801) 532-1234
Fax: (801) 536-6111
Email: DMcCarthy@pblutah.com